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10/828,661	04/21/2004	Raymond A. McClanahan	MCL-2.001.US	4929
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GANZ LAW, P.C. P O BOX 2200 HILLSBORO, OR 97123				
EXAMINER				
LEWIS, KIM M				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/828,661

**Applicant(s)**

MCCLANAHAN ET AL.

**Examiner**

Kim M. Lewis

**Art Unit**

3772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 and 17-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 17-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date 1/22/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☒ Other: Detailed Action

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 1/22/08 has been received and made of record. Note the acknowledged form PTO-1449 enclosed herewith.

### ***Response to Amendment***

2. The amendment filed on 1/22/08 has been received. As requested, claims 1-4, 9, 15, 17 and 27-29 have been amended, and claim 16 has been cancelled.
3. Claims 1-15 and 17-30 are pending in the instant application.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

5. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,095,664 ("Grenfell").
6. As regards claim 1, as can be seen from Fig. 1, Grenfell clearly anticipates applicant's presently claimed invention with the exception of the hour-glass shape. However, applicant should note that when the columns are placed between the toes of a user, they will have an hour glass shape.
7. Re. claim 2, as can be seen from Fig. 2, the thickness of the column is non-uniform since tube (1) runs through the column.

8. Claims 4 and 12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 1,930,413 ("Bruel").

Re. claim 4, note Figs. 1, 8 and 3.

Re. claim 12, note Fig. 9.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 3-11, 13-15 and 17-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grenfell in view of U.S. Patent No. 1,080,304 ("Scholl").

Re. claims 3 and 6, Grenfell fails to teach a pressurizable bladder. Scholl discloses a toe spreader that include various inserts, including a pressurizable bladder, for insertion into a column in the toe spreader to rigidify the column. It would have been

obvious to one having ordinary skill in the art to provide the toe spreader of Grenfell with a pressurizable bladder insert in order to add stiffness to the spreader.

Re. claim 4, note the rejection of claim 1 above. In further regards to claim 4, applicant should note that once modified it would have been obvious to one to provide the insert such that the insert and column are generally isometric and isomorphic to one another.

Re. claim 5, as can see from Fig. 4, the recess is capable of receiving an insert.

As regards claim 7, Scholl discloses the spacer of claim 4, wherein the insert is a pressure-adjustable pneumatic cushion. Scholl fails to disclose a hydraulic bladder. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the pneumatic cushion of Scholl for a hydraulic cushion or bladder since they perform the same function of rigidifying the column.

Re. claims 8 and 9, Grenfell discloses the space is constructed from rubber, which, is an elastomer, and which is soft, durable and shape-retentive and urges the toes apart. (page 1, lines 45-36).

Re. claim 10, note Fig. 4.

Regarding claims 11 and 13, Grenfall does not disclose the particular shape of is of a generally circular disk shape having opposing tabs extending radially from the center and fails to teach the recess is of a generally circular disk shape and wherein the insert is of a generally circular disk shape, wherein the recess and the insert are generally isometric and isomorphic to one another. However, the cotton filling material, once inserted in the tube, will take the form of tube. As to the tabs, one having ordinary

skill in the art would have found it *prima facie* obvious to add tabs to the insert in order to allow for easy removal of the insert.

Re. claims 15 and 17, note the rejection of claims 3, 4, and 14 above.

As regards claim 18, the modified device of Grenfell discloses the apparatus of claim 17, except wherein the apparatus comprises four of the spacers having four recesses therein and four of the inserts within the four recesses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to add additional spacers to fit between additional toes, since it has been held that the mere duplication of essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.* 193 USPQ 8.

With respect to claim 19, the limitation "wherein the four spacers and the one or more web structures are formed together by integrally molding the same", is not given patentable weight since the method of forming the device is not germane to the issue of patentability of the device itself.

With respect to claim 20, Grenfell discloses the tubes are constructed from pliable rubber, thereby being elastomeric material. It then follows that additional tubes would also be made from the same elastomeric material.

With respect to claim 21, Scholl fails to teach that the inserts are formed of an elastomeric material having a defined width that fixes a desired inter-digital spacing. Wall discloses cotton or other suitable matter as the material for the insert. It would have been obvious to one having ordinary skill in the art to modify the material of the insert to include an elastomeric material, since it has been held that the selection of a

known material based upon its suitability is a design consideration within the level of ordinary skill in the art. *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

With respect to claim 22, the modified device of Grenfell discloses the apparatus of claim 20.

With respect to claim 23, once modified to include the four spacers, the spacers will be adhered (connected) at the respective upper and lower regions thereof to the one or more web structures.

As regards claim 24, the modified device of Grenfell discloses the apparatus of claim 23, wherein the one or more web structures are curved in an arc conforming to an arc of the toes during use and fix the four spacers in an arc corresponding thereto during use.

As regards claim 25, the modified device of Grenfell discloses the apparatus of claim 24, wherein the four recesses extend through the four columns from the top region toward the bottom region thereof, and wherein the four recesses are dimensioned to accommodate therein shims selected from a group of shims of various widths.

Re. claims 27 and 28, the claimed methods are practiced by mere use of the modified device of Grenfell as disclosed above in the rejection of claim 15.

As to method claim 29, the modified device of Grenfell discloses the inherent method as presently claimed including the steps of fitting a foot of a user with an appliance having spacers (2,3) for extending between pairs of adjacent toes and for spreading the same relative to one another, and adjusting the width of individual ones of

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such spacers to a desired spacing for each pair of adjacent toes on the foot of the user. Grenfall fails to teach wherein the adjusting includes selecting and inserting pressurizable bladders of adjustable width into corresponding recesses formed within the bodies of the spacers. However, the device has been modified to include a pressurizable bladder(s). Thus, the claimed method is disclosed by the combination of Grenfall and Scholl.

Re. claims 14, 26 and 30, Grenfall fails to teach a fastener/ interconnecting web structure. Scholl, however, discloses a fastener (anchoring structure 20, 21 and page 1, lines 103-109) for attaching the spreader to the foot of the user. It would have been obvious to one having ordinary skill in the art to modify Grenfall to include a fastener structure/ Interconnecting web structure such as the one taught by Scholl, in order to maintain the spreader on the foot without it being dislodged.

### ***Response to Arguments***

12. Applicant's arguments with respect to claims 1-17 and 19-30 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Wednesday to Friday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kim M. Lewis/  
Primary Examiner  
Art Unit 3772

kml  
5/11/08